ESTTA Tracking number: **ESTTA322800**

Filing date: **12/18/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77589735
Applicant	Adventist Health System/Sunbelt, Inc.
Applied for Mark	HEALTH VILLAGE
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Submission	Appeal Brief
Attachments	Health Village IC 36 Appellate Brief.tif (8 pages)(359559 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application for "HEALTH VILLAGE"	)	Law Office 108
	)	
Serial No.: 77/589735	)	Trademark Attorney
	)	Heather A. Sapp
Filed: October 9, 2008	)	
	)	
Applicant: Adventist Health System/Sunbelt, Inc.	)	
	)	

BRIEF FOR APPLICANT

INTRODUCTION

Applicant hereby appeals from the Examining Attorney's refusal to register (allow) the above-identified mark, dated May 20, 2009, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision.

APPLICANT'S TRADEMARK

Applicant seeks registration on the Principal Register of its mark, HEALTH VILLAGE, for "real estate rental services, namely, rental and leasing of houses, accessory apartments, cottages, townhouses, multi-family apartments, condominiums and commercial buildings, offices and facilities; management of residential and commercial real estate."

The Examining Attorney did not cite any prior registrations against Applicant's mark.

PROCEDURAL HISTORY

The Examining Attorney initially refused registration of Applicant's mark by an Office Action dated October 15, 2008, concluding that the term "Health Village" is merely descriptive of the listed services after reviewing "the [A]pplicant's other applications for the identical mark, many of which have had to do with the healthcare field" and observing that "Applicant's name is 'Adventist Health System/Sunbelt, Inc.'" The Examining Attorney's conclusion was based on

her assumption that Applicant intended "to offer real estate services, namely rental of residential housing in a managed care/senior living community where healthcare is a big component of the services offered." In Applicant's response to the initial refusal to register, filed on January 30, 2009, Applicant demonstrated that the real estate services to be offered under the mark are not limited in scope to healthcare being a major component of the services offered. Rather, the real estate services to be offered include the rental and leasing of residential and commercial property in general.

In the second Office Action, dated February 23, 2009, the Examining Attorney agreed with Applicant's response and decided to withdraw the merely descriptive refusal. However, the Examining Attorney next required the Applicant to disclaim a portion of the mark that the Examining Attorney considered to be merely descriptive. The Examining Attorney required Applicant to disclaim the term "VILLAGE" because, in her opinion, it merely described a function or feature of Applicant's services. Furthermore, the Examining Attorney attached 18 third-party registrations to the second Office Action to demonstrate probative evidence on the issue of descriptiveness.

In Applicant's response to the second Office Action, filed on April 30, 2009, Applicant demonstrated that the term "VILLAGE" was suggestive, not merely descriptive, because the term does not provide specific information about any type of services and does not describe any of the listed services themselves. In addition, Applicant established that there is no conclusive evidence that "VILLAGE" is descriptive based on disclaimers of other applicants and offered numerous third-party registrations featuring similar services that did not disclaim the term "VILLAGE." Nonetheless, the Examining Attorney reiterated her position in a Final Office Action, dated May 20, 2009, finding Applicant's argument to be unpersuasive and restated her

belief that "VILLAGE" is merely descriptive of Applicant's offered services despite Applicant's submission of arguments and evidence to the contrary.

THE ISSUE

The sole issue presented by this appeal is whether the Examining Attorney has established that the term "VILLAGE" as used in Applicant's mark is merely descriptive of the services to be offered by Applicant that would require a disclaimer by Applicant.

ARGUMENTS

"It has been long acknowledged that there is a very narrow line between terms which are merely descriptive and those which are only suggestive," and the borderline between the two is hardly a clear one. In re Atavio Inc., 25 U.S.P.Q.2d 1361, 1362 (T.T.A.B. 1992). Where there are doubts as to registrability of marks, particularly in "dealing with a fine and frequent subject line of demarcation between suggestive and the merely descriptive designation," doubts in such cases are to be resolved in favor of applicant. In re Officers' Organization for Economic Benefits, Ltd., 221 U.S.P.Q. 184, 186 (T.T.A.B. 1983).

I. THE EXAMINING ATTORNEY FAILED TO MEET HER BURDEN OF PROOF THAT THE TERM "VILLAGE" IS MERELY DESCRIPTIVE OF THE SERVICES TO BE OFFERED BY APPLICANT.

"Generally speaking, if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive." Union Carbide Corp. v. Ever-Ready Inc., 188 U.S.P.Q. 623, 635 (T.T.A.B. 1976)(quoting A. Seidel, S. Salroff, and E. Gonda, Trademark Law and Practice § 4.06 at 77 (1963)).

A. The term "VILLAGE" does not directly impart information about Applicant's listed services.

Applicant's use of the term "VILLAGE" in its mark does not describe the services to be offered. Specifically, the term "VILLAGE" does not directly impart information about real estate rental services or management of residential and commercial real estate. The Merriam-Webster's Dictionary (2008) defines "village" as either a settlement usually larger than a hamlet and smaller than a town, or an incorporated minor municipality. The Examining Attorney provided the following alternative meanings: "a community of people smaller than a town," or "a settlement smaller than a town." None of the definitions relates to rental services or the management of real property. Simply put, the term "VILLAGE" is a very broad term that connotes many different groupings of people, buildings, or structures without conveying an immediate idea of a function or feature with respect to real estate rental services or management of residential and commercial real estate.

As stated by the Examining Attorney in her Final Office Action, dated May 20, 2009, "[t]he specific wording of applicant's identification of services suggests a grouping of buildings in the immediate vicinity of each other, organized like a little town, ie., a village." (emphasis added). Applicant agrees with the Examining Attorney that the term "VILLAGE" is suggestive, not merely descriptive, of the services to be offered under the mark. Therefore, the Examining Attorney's concern that the use of "VILLAGE" in Applicant's mark is merely descriptive of Applicant's services is unfounded, and the requested disclaimer unnecessary.

B. The term "VILLAGE" is suggestive of the listed services because it requires thought, imagination and perception to know the specific types of services to be provided by the Applicant.

If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what service characteristics are indicated by the term, the term is suggestive rather than merely descriptive. In re Tennis in the Round, Inc., 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978). The term "VILLAGE" does not directly describe any aspect of real estate rental services or management. Accordingly, the term "VILLAGE" is one step removed from being merely descriptive because it only suggests that the real estate rental services or management to be offered by Applicant will be organized as a settlement or town. This multi-stage reasoning process embodies thought and imagination, which are the touchstones of a suggestive term. Rather than being merely descriptive, the term "VILLAGE" is suggestive of the organization of buildings or structures in connection with Applicant's listed services and, therefore, no disclaimer is required.

II. THIRD PARTY REGISTRATIONS DEMONSTRATE A LACK OF CONCLUSIVE EVIDENCE THAT THE TERM "VILLAGE" IS MERELY DESCRIPTIVE.

Applicant acknowledges that each case is decided on its own facts and that prior decisions and actions of other trademark examining attorneys in registering different marks are not binding upon the U.S. Patent and Trademark Office. See In re Int'l Taste, Inc., 53 U.S.P.Q.2d 1604, 1606 (T.T.A.B. 2000). However, the Examining Attorney attached 18 third-party registrations to her second Office Action, dated February 23, 2009, that disclaimed the term "VILLAGE" and that listed services similar to Applicant's. The Examining Attorney argued that these third-party registrations were probative evidence that the term "VILLAGE" was merely descriptive. Applicant, however, found 105 live records on the Principal Register of

third-party registrations featuring similar services in the same classification as Applicant that were not required to disclaim the term "VILLAGE." An identical search for third-party registrations featuring similar services that have disclaimed the term "VILLAGE" yielded only 57 live records. These records support Applicant's position that there is a lack of conclusive evidence that the term "VILLAGE" is merely descriptive based on third-party registrations for similar services.

Applicant selected ten samples from the 105 registrations for illustrative purposes and attached them to Applicant's response to the second Office Action, filed on April 30, 2009. In much the same way as displayed in Applicant's mark, "VILLAGE" is used in a purely suggestive capacity. For example:

- VACATION VILLAGE (Reg. No. 3,147,120): management of time share interests in real estate.
- HEIGHTS VILLAGE (Reg. No. 3,047,617): real estate services, namely, leasing and managing commercial property; and real estate agencies in the fields of commercial property.
- RIVER VILLAGE (Reg. No. 2,725,760): real estate management.
- HEALTHCARE VILLAGE (Reg. No. 2,412,877): leasing of medical offices and clinics for others.
- COLONIAL VILLAGE (Reg. No. 2,113,050): real estate leasing services, namely, apartments.

Being suggestive, these applications were not required to disclaim the term "VILLAGE" as a condition to registration. If the marks that deal with real estate rental services or management as described above were not required to disclaim "VILLAGE," then it should follow that Applicant's mark need not either, because the use of "VILLAGE" in Applicant's mark is at least as suggestive as the use in the sample marks. Moreover, there is no conclusive evidence that the term "VILLAGE" is merely descriptive because fewer third-party registrations were required to disclaim the term than third-party registrations not disclaiming the term.

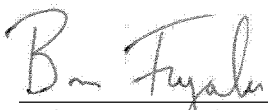
III. DOUBTS RESOLVED IN FAVOR OF APPLICANT.

When there is doubt about whether a term is descriptive or suggestive when used in connection with an identified service, doubt must be resolved in favor of the applicant and publication of the designation for potential opposition. See In re Grand Metropolitan Food Service, Inc., 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994); In re Intelligent Medical Systems, Inc., 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987); In re Aid Laboratories, Inc., 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983).

IV. CONCLUSION

For the reasons set forth above, Applicant submits that that the Examining Attorney did not meet her burden of proof that the term "VILLAGE" in Applicant's mark is merely descriptive, because the term is, in fact, suggestive. Accordingly, Applicant respectfully requests the Trademark Trial and Appeal Board reverse the Examining Attorney's decision requiring a disclaimer of the term "VILLAGE" prior to registration of Applicant's mark.

Respectfully submitted:



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